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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,612 06/18/99 BENDINER

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BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO IL 60610

EXAMINER
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CROSS, L	
ART UNIT	PAPER NUMBER

1743

20

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/336,612

Applicant(s)

BENDINER, BERNARD

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office Action is in response to Applicant's amendment filed on July 30, 2001 and entered as Paper No. 19. Claims 1 and 2 are pending in the instant application.

#### ***Withdrawal of Rejections from Previous Office Action***

The rejection of claim 1 under 35 USC 103 over Stricklin et al '174 is withdrawn in view of Applicant's amendment to the amount of potassium sorbate.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites a range of potassium sorbate as 0.3-1.75% by weight. Claim 1, upon which claim 2 depends, recites the amount of potassium sorbate as being 0.3% by weight. In claim 2, Applicant attempts to redefine what has already been set forth in claim 1. To avoid confusion and clarity problems, Applicant should consider amending claim 2 such that it is in independent form and not dependent upon claim 1.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,027,687 to Nakajima et al (hereinafter Nakajima et al '687).

Applicants' invention is directed to an aqueous solution comprising potassium sorbate and water, wherein the potassium sorbate is present in an amount of at least 0.3% and wherein the solution has a pH of 4.5 or higher.

Nakajima et al '687 teach a composition for effectively preventing the occurrence of corrosion in water tubes or boilers. The composition of Nakajima et al '687 comprises, among other things, potassium sorbate, present in the amount of 0.2-2% by weight. Both examples in Table I use a pH of about 11.

It is noted that the reference does not specifically state that the resulting solution has a lower electrical conductivity and lower oxygen content, however, compositions comprising the same components present in the same amounts presumably have the like properties and characteristics. See MPEP 2112.01.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 103 in view of the teachings of Nakajima et al '687.

Art Unit: 1743

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,559,103 to Nomura et al (hereinafter Nomura et al '103).

Nomura et al '103 teach paper for packaging metallic materials. The paper is impregnated with chemicals having a rust prevention effect consisting of an inhibitor and sterilizer. Nomura et al '103 disclose the sterilizer as alkali salts of sorbic acid, such as potassium sorbate (col. 5, lines 21-31). The reference further teaches that the sterilizer is present in an amount of 0.01 – 3% by weight (col. 5, lines 62-66). In Example 24 of the reference, potassium sorbate is added to the paper product at a pH of 7.4. During the anti-rust test, the paper demonstrated enhanced rust prevention where potassium

Art Unit: 1743

sorbate was included than where potassium sorbate was absent. See Table 8, Example 24 and comparative example 15.

Nomura et al '103 differ from the instantly claimed invention in that the specific range of 0.3-1.75 is not disclosed. Nomura et al '103 does, however, disclose a range of 0.01-3, which fully encompasses that claimed by Applicant. Therefore, given the disclosure of Nomura et al '103, it would have been obvious to one of ordinary skill in the art to use the particular range claimed by Applicant since the range is taught by Nomura et al '103 in its entirety.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Nomura et al '103.

### ***Response to Arguments***

3. Applicant's arguments filed July 30, 2001 have been fully considered but they are not persuasive. Applicant's arguments, regarding the Nakajima et al reference, are directed to 1) Nakajima's lack of disclosure stating that the potassium sorbate provides corrosion resistance, 2) function of potassium sorbate as a stabilizer and 3) lack of disclosure of the electrical conductivity and oxygen content of the composition.

With respect to the function of potassium sorbate and whether the reference teaches that the potassium sorbate provides corrosion resistance, it is well settled that in claims directed to a composition, the function of the components does make the claims patentable where the composition itself is taught by the prior art. Applicant

Art Unit: 1743

should note that the claimed invention is extremely broad in that that it comprises only potassium sorbate in a specified amount. Applicant's use of "comprising" language does not limit the claim to potassium sorbate alone and allows any other components to be present. Applicant is correct in pointing out the additional components of Nakajima et al, however, this does not obviate the teachings of potassium sorbate in the reference. Applicant has attempted to incorporate the limitations of electrical conductivity and oxygen content to distinguish the present invention from that of the prior art; however, even these limitations recite properties of the composition and do not lend to its constituency. The examiner notes Applicant's argument that the composition of Nakajima et al is not the exact same as that of Applicant; however, Applicant has not proven that the composition of Nakajima et al does not have a lower electrical conductivity and lower oxygen content. It remains to be the position of the Examiner that Nakajima's teaching of potassium sorbate in essentially the same amount and pH claimed anticipates the claimed invention and that the properties of the composition are presumed inherent.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1743

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

LIC

October 9, 2001

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700